

REMARKS

The Examiner rejected claims 1, 4-10, 12-17 and 19-21 under 35 U.S.C. §101 as allegedly lacking patentable utility.

The Examiner rejected claims 1, 4-8, 12-17 and 19-21 under 35 U.S.C. §102(b) as allegedly being anticipated by the alleged reference “Death Visualization Therapy” by Arnold P. Nerenberg, PhD.

The Examiner rejected claims 9-10 under 35 U.S.C. §103(a) as allegedly being unpatentable over Death Visualization Therapy, by Arnold P. Nerenberg, PhD in view of Official Notice.

Attached herewith is a Declaration under 32 CF.R. §1.132.

Applicants respectfully traverse the §101, §102 and §103 rejections with the following arguments.

35 U.S.C. §101

The Examiner rejected claims 1, 4-10, 12-17 and 19-21 under 35 U.S.C. §101 as allegedly lacking patentable utility. The Examiner alleges: "Claims 1 and 19 define a therapeutic method "for improving a relationship between a living first person and a living second person" and define a series of steps for conducting this method. Upon reconsideration, the invention as presently being claimed is considered to be lacking in the requirement for a "useful, concrete and tangible result" from the method steps which are being applied. See MPEP 2106, Section IIA; State Street Bank & Trust Co. vs. Signature Financial Group Inc., 149 F.3d 1368, 1374, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998); In re Schrader 22F.3d 290, 297-298, 30 USPQ2d 1455, 1461-62 (Fed. Cir. 1994). ... Although the preambles of claims 1 and 19 do define a result of "improving a relationship", this is only a functional recitation of a result. In addition, the result of "improving a relationship" is not considered to define a "useful, concrete and tangible result". Accordingly, claims 1 and 19 lack utility under 35 USC 101. Claims 4-10, 12-17 and 20-21 depend from claims 1 and 19."

In response, Applicants have amended the preamble of claims 1 and 19 to clarify the utility of the invention.

35 U.S.C. §102

The Examiner rejected claims 1, 4-8, 12-17 and 19-21 under 35 U.S.C. §102(b) as allegedly being anticipated by the alleged reference “Death Visualization Therapy” by Arnold P. Nerenberg, PhD. Hereinafter, the reference of “Death Visualization Therapy” by Arnold P. Nerenberg, PhD is identified as the “DVT Reference”.

As to claim 1, the Examiner alleges: “Page 8 describes the provision of a coffin in a closed room for the purpose of conducting a psychological therapeutic method. As described on page 19, a first person (Joe's Mother) and a second person (Joe) and brought into the room. The second person (Joe) is directed to lay in the coffin. The first person (Joe's mother) can see the second person (Joe) in the coffin and is directed to speak to the second person (Joe) in regards to their personal relationship. Neither the first person or second personal are rehearsing or acting in a theatrical performance.”

Applicants respectfully contend that the DVT Reference does not anticipate claims 1 and 19, because the DVT Reference does not teach each and every feature of claims 1 and 19.

As a first example of why the DVT Reference does not anticipate claims 1 and 19, Applicants respectfully contend that the DVT Reference does not teach “wherein the coffin is visually available to the first person”. The Examiner has identified Joe’s mother as the first person. The Examiner cited page 8 of the DVT Reference, but on page 8 of the DVT Reference, Joe’s mother is not even mentioned. The Examiner cited page 16 of the DVT Reference, but page 16 of the DVT Reference does not teach that the coffin is visually available to Joe’s mother. In fact, page 16 of the DVT Reference does not teach that that Joe’s mother is in the same room as the coffin. Page 16 of the DVT Reference teaches only that Joe’s mother is in audio

communication with Joe. Joe's mother could engage in said audio communication with Joe without the coffin being visually available to her. For example, there could be an opaque partition between Joe's mother and the coffin that block's a view of the coffin from Joe's mother. As a second example, Joe's mother could be in another room and be in telephone or equivalent electronic communication with Joe. As a third example, the coffin could be in a closed room with no windows and no illumination wherein the room is pitch black such that the coffin is not visually available to anyone in the room.

As a second example of why the DVT Reference does not anticipate claims 1 and 19, Applicants respectfully contend that the DVT Reference does not teach "directing the first person to see the second person as being in the coffin". Page 8 of the DVT Reference is not relevant to this feature because the first (Joe's mother) is not mentioned on page 8 of the DVT Reference. On page 16 of the DVT Reference, the only direction received by Joe's mother is: "I would have ... had his mother speak what was in her heart" which does not teach "directing the first person to see the second person as being in the coffin".

As a first additional matter specific to claim 19, Applicants respectfully contend that the DVT Reference does not teach the following feature of claim 19: "questioning a first person using first questions having **predetermined fixed responses**" (emphasis added). The Examiner alleges: "Prior to the implementation of the method, both the first person (Joe's Mother) and the second person (Joe) are questioned (page 6, entire page)." In response, Applicant's note that the only question asked of the first person (identified by the Examiner as Joe's mother) is: "Is that correct?" Mom's response is: "I would gladly give my kidney, my life, or anything he needs." Hence Applicants maintain that from the context of the preceding question and answer, the

preceding question is not a question having a predetermined fixed response as required by claim 19.

As a second additional matter specific to claim 19, Applicants respectfully contend that the DVT Reference does not teach the following feature of claim 19: **“if the evaluating determines that the therapeutic method should continue: providing ...; having...;directing...; and instructing”** (Emphasis added). Applicants maintain that page 6 of the DVT Reference does not teach performing the additional method steps (“providing ...; having...;directing...; and instructing”) **conditionally** based on whether “the evaluating determines that the therapeutic method should continue”, as required by claim 19.

Based on the preceding arguments, Applicants respectfully maintain that does not anticipate claims 1 and 19, and that claims 1 and 19 are in condition for allowance. Since claims 4-10 and 12-17 depend from claim 1, Applicants contend that claims 4-10 and 12-17 are likewise in condition for allowance. Since claims 20-21 depend from claim 19, Applicants contend that claims 20-21 are likewise in condition for allowance.

Additionally, Applicants respectfully dispute the Examiner’s allegation that the DVT Reference is a reference that could be used against the claims of the present patent 35 U.S.C. §102(b). At issue is the date at which the DVT Reference became publicly available. The Examiner alleges that the date at which the DVT Reference became publicly available is March 20, 1999, based on the following argument: “The reference to Death Visualization Therapy is a booklet published by the inventor of record in the present application. Records from the U.S. Copyright Office indicate that a copyright for this booklet was registered on December 27, 1999.

A copy of the copyright record obtained from the U.S. Copyright Office pertaining to this same booklet indicates publication on March 20, 1999. Since the publication date of March 20, 1999 is more than one year prior to the effective filing date of the present application, and meets the requirement of being "described in a printed publication" under 35 USC 102(b), the reference to Death Visualization Therapy is considered to be applicable as prior art under 35 USC 102(b)."

The Examiner additionally argued: "Applicant's declaration has been considered. Applicant states that the Death Visualization Therapy booklet was published on March 20, 1999, but that only a single copy of the booklet was published on that date, and that the single copy was not publicly distributed or otherwise made available to the public... The question of how many booklets were actually published is considered to be moot, since a statutory bar under 35 USC 102(b) can be established by even one publication made available to the public. See MPEP 2133.03(a); Ex parte Hershberger 96USPQ54, 56 (Bd.App. 1952); Egbert v. Lippmann 104 U.S. 333, 336 (1881). Applicant's copyright registration for the Death Visualization Therapy booklet submitted to the US Copyright Office indicate a date of publication of March 20, 1999, more than one year prior to the effective filing date of the present application. By definition, the publication date listed in a U.S. copyright record is "the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease or lending". See Copyright Registration Form TX, page 2, section 3 entitled "Creation and Publication"; Frequently Asked Questions About Copyright, item #38, "What is publication?". Copies of these references are cited with this action.... Since the date of publication listed in the copyright record is considered to be a distribution of the work to the public, the date of publication listed in the copyright record is not supported by applicant's statements that the booklet was not made public,

and establishes the booklet as prior art under 35 USC 102(b).”

In response to the preceding arguments by the Examiner, Applicants respectfully contend that the date at which the DVT Reference became publicly available is after December 20, 1999, based on the following analysis, based on the case of *Ex parte Research and Mfg. Co.*, 10 USPQ.2d 1657 (Bd. Pat. App. & Interferences March 9, 1989). In *Ex Parte Research*, the Board reversed the Examiner’s rejection of claims 1, 11, and 21 under 35 U.S.C. §102(b) as allegedly being anticipated by a publication identified as the Sorvall bulletin. The basis for the Examiners rejection was that the Sorvall bulletin was listed on a copyright registration form as having a date of publication of June 2, 1969, which is more than one year prior to the filing of the patent application at issue. The Board’s analysis for reversing of the Examiner’s rejection is as follows:

“[T]he certificate of registration provides *prima facie* evidence that the Sorvall bulletin 26-69 was a ‘printed publication’ under the provisions of 35 USC 102(b).

However, the *prima facie* evidence may be rebutted by convincing factual evidence to the contrary. As rebuttal evidence, appellant has presented copies of a letter from Mr. Clutter to Dr. Christensen dated May 28, 1969 requesting that Dr. Christensen “review” a “supplementary bulletin detailing the FTS that John Evans wanted to take on his tour of Europe.” Also of record is a return letter from Dr. Christensen to Mr. Clutter dated June 5, 1969 stating that Dr. Christensen had “taken the liberty of revising the text, and a copy of the revised version is enclosed.” Attached to Dr. Christensen’s letter is a copy of what is asserted to be the revision. Additionally, appellant has proffered an affidavit of Cyrus G. Lindgren dated September 5, 1987, in which Mr. Lindgren asserts that “Bulletin 26-69 was printed as preliminary product information for use within the company,” and that “Bulletin 26-69 was not distributed to sales personnel of Ivan Sorvall, Inc. or others” because it had [*14] been “immediately criticized and revised by Dr. Christensen resulting in the preparation of Bulletin 28-69. Copies of Bulletin 26-69 were therefore of no use to the company and were destroyed.” Mr. Lindgren also states that, with regard to the application for Copyright Registration A90038, that he “recalls that he did not, himself, prepare this application,” and “states to the best of his knowledge that the June 2, 1969 date contained in Sections 4 and 11 of the application referring to the date of publication of Bulletin 26-69 is inaccurate. This Bulletin was never put into use or distributed . . .”

On the basis of the evidence before us, it seems apparent that the Sorvall Supplementary Bulletin 26-69 was only distributed within the company and to Dr. Christensen. Although there were apparently no restrictions placed on Dr. Christensen's use of the bulletin, Dr. Christensen was, in our view, within the employ of Ivan Sorvall, Inc., and therefore the bulletin apparently was never circulated or distributed outside the company or its employees. We refer to the letter of Dr. Christensen to Mr. Baranowski dated June 3, 1987 (Patent Owner's citation BI, Paper No. 11) as evidence [*15] of the relationship between Sorvall and Dr. Christensen. Dr. Christensen states in the penultimate paragraph thereof that "[m]y financial arrangement with Sorvall was a 5% royalty on all FTS instruments sold for the first 5 years. After the 5 years were up, I had little further contact with Sorvall."

Thus, in view of the evidence before us, it appears that the Sorvall Supplementary Bulletin 26-69 was not "placed on sale, sold, or publicly distributed" (17 USC 26). Therefore, not only was the June 2, 1969 date "inaccurate" as the date of publication, but the Sorvall Supplementary Bulletin 26-69 was not even "published" under the meaning of the copyright laws. Therefore, we find that the evidence of record rebuts the *prima facie* evidence of the fact stated in item 4 of the application for registration of a claim to copyright that June 2, 1969 was the date of publication of the Sorvall Supplementary Bulletin FTS 26-69."

Id. At 1560-61.

Thus, the Board first considered that the publication date on the copyright registration to be *prima facie* evidence of a date of publication of June 2, 1969 of the Sorvall bulletin. Then, the Board held that the date of June 2, 1969 was not the date of publication of the Sorvall bulletin, based on the rebuttal evidence submitted. For the present patent application, Applicants next provide arguments as to why an application of the Board's holding in *Ex parte Research and Mfg. Co.* leads to the conclusion that the date of publication of the DVT Reference used to reject claims of the present patent application does not have the publication date of March 20, 1999 listed on the DVT Reference copyright application.

The following rebuttal evidence was submitted in *Ex parte Research and Mfg. Co.*:

1) the letter from Mr. Clutter to Dr. Christiansen;

- 2) the return letter from Dr. Christiansen to Mr. Clutter; and
- 3) Mr. Lingren's affidavit.

Similarly, Applicants have offered the following rebuttal evidence:

- 1) a receipt for 110 copies of the DVT Reference dated December 22, 1999; and
- 2) Dr. Nerenberg's Declaration under 32 CF.R. §1.132 filed herewith.

Applicants respectfully submit that Applicants' rebuttal evidence item 1) (receipt for 100 copies) is analogous to rebuttal evidence items 1) and 2) in Ex parte Research and Mfg. Co. (Letter and return letter). For both cases (i.e., Ex parte Research and Mfg. Co. And the instant patent application) said rebuttal evidence does not rigorously prove that the publication at issue was not published on the date of publication listed on the copyright application. The letter and return letter in Ex parte Research and Mfg. Co. is merely indicative of an allegation that the original copy existing on June 2, 1969 was edited after June 2, 1965, but does not rigorously prove that the original copy existing on June 2, 1969 was not publicly available on June 2, 1969. Similarly, the receipt for 100 copies in the instant case does not rigorously prove that the copy of the DVT reference existing on March 20, 1999 was not publicly available on March 20, 1999. Nonetheless, the rebuttal evidence items 1) and 2) in Ex parte Research and Mfg. Co. were considered by the Board as persuasive as providing evidence on non-publication, even though said rebuttal evidence items 1) and 2) do not negate the possibility that the Sorvall publication could have been publicly available on June 2, 1969. Similarly, the receipt for the 100 copies in the instant case is evidence in support of a need to make the DVT reference publicly available after

December 20, 1999, since it is normal practice to publish multiple copies of a book when making a book publicly available. Moreover, with only a single copy existing on March 20, 1999 it is reasonable to suppose that the author Dr. Nerenberg would want to keep the single copy (and only existing copy) for himself until such time that other copies could be made for available or distribution to others. In any event, Applicants respectfully maintain that the receipt for the 100 copies in the instant case is at least as persuasive (as rebuttal evidence) as is items 1) and 2) in Ex parte Research and Mfg. Co. Thus, Applicants respectfully submit that the receipt for the 100 copies in the instant case is sufficiently persuasive, based on Ex parte Research and Mfg. Co.

Applicants respectfully submit that Applicants' rebuttal evidence item 2) (Declaration under 32 CF.R. §1.132) is analogous to rebuttal evidence item 3) in Ex parte Research and Mfg. Co. (Mr. Lingren's affidavit). First, Mr. Lingren's affidavit asserts that the Sorvall Bulletin was not distributed to sales personnel of Ivan Sorvall, Inc. or others. Similarly, Dr. Nerenberg's Declaration asserts that the single copy of the DVT Reference was not publicly distributed or made publicly available. Second, Mr. Lingren's affidavit asserts that Mr. Lingren did not prepare the copyright application. Analogously, Dr. Nerenberg asserts that Dr. Nerenberg prepared the copyright application himself without the assistance or advice of legal counsel and that he mistakenly thought that the date of publication on the copyright application meant the date of printing. Applicants maintain that Dr. Nerenberg's Declaration is probably more persuasive than Mr. Lingren's affidavit, since Mr. Lingren did not produce any evidence that the person who filled out the copyright application was under a mistaken impression that the date of publication on the copyright application meant something other than the date of public availability. Yet, the Board found Mr. Lingren's affidavit to be persuasive. In any event, Applicants respectfully maintain that

Dr. Nerenberg's Declaration in the instant case is at least persuasive (as rebuttal evidence) as is Mr. Lingren's affidavit in Ex parte Research and Mfg. Co. Thus, Applicant's respectfully submit that Dr. Nerenberg's Declaration in the instant case is sufficiently persuasive, based on Ex parte Research and Mfg. Co.

Based on the preceding arguments, Applicants respectfully contend that the holding in the Ex parte Research and Mfg. Co. case makes it clear that the DVT Reference cannot be used as prior art against the claims in the present patent application.

35 U.S.C. §103

The Examiner rejected claims 9-10 under 35 U.S.C. §103(a) as allegedly being unpatentable over the DVT Reference in view of Official Notice. Since claims 9-10 depend from claim 1, which Applicants have argued *supra* to be patentable under 35 U.S.C. §102, Applicants maintain that claims 9-10 are not unpatentable under 35 U.S.C. §103(a).

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below.

Date: 10/28/2003

Schmeiser, Olsen & Watts
3 Lear Jet Lane, Suite 201
Latham, New York 12110
(518) 220-1850

Jack P. Friedman
Jack P. Friedman
Registration No. 44,688